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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Plan-A-Day Enterprises, Ltd.

Serial No. 75/807,555

Nathaniel D. Kramer of Cobrin & Gittes for Plan-A-Day
Enterprises, Ltd.

Ronald McMorrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Plan-A-Day Enterprises, Ltd. seeks to register DAILY
PLANNER for "mail order catalog services featuring
stationery and related gift items, especially desk
accessories, globes, atlases, travel clocks and timepieces;
computerized on-line retail services featuring stationery
and related gift items, especially desk accessories,

globes, atlases, travel clocks and timepieces.”¹ When the Trademark Examining Attorney refused registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1) on the ground that the applied-for term was merely descriptive because it was generic, applicant amended its application to seek, in the alternative, registration under the provisions of Section 2(f) of the Act. The Examining Attorney maintained the Section 2(e)(1) refusal, and essentially rejected the claim of acquired distinctiveness on the basis that the wording is generic.

When the refusal of registration was made final, applicant filed the instant appeal.

Both applicant and the Examining Attorney have filed appeal briefs; an oral hearing was not requested.

It is the Examining Attorney’s position that DAILY PLANNER is a generic term for some of the goods sold by applicant through its mail order and on-line retail services, and therefore the term is not only merely descriptive of applicant’s services, but is generic for them and as such not registrable pursuant to Section 2(f).

The Board recently had occasion to consider the genericness of THE DAILY PLANNER in a companion application

¹ Application Serial No. 75.807,555, filed September 24, 1999, and asserting a bona fide intention to use the mark in commerce.

filed by applicant for the same services. The mark in that case was for the words THE DAILY PLANNER written around a central "DP" written in upper case script, all of which appears on a scalloped circular background to create an overall impression of a seal or imprint. The issue in that case was whether a disclaimer of DAILY PLANNER was warranted because the term was generic, or whether it had acquired distinctiveness, and therefore the issue in this case and that in the companion case is the same. The Board found that THE DAILY PLANNER is generic for applicant's services, and affirmed the requirement for a disclaimer. **In re Plan-A-Day Enterprises, Ltd.**, Serial No. 75/807,556 (TTAB July 3, 2002).

Applicant has acknowledged that the mark DAILY PLANNER is "substantially the same" as THE DAILY PLANNER, differing only with regard to the article THE. In fact, applicant relied on a declaration originally submitted in connection with the THE DAILY PLANNER application to prove the subject mark has acquired distinctiveness. Response filed August 11, 2000. Accordingly, we think it appropriate to quote from the Board's opinion in the appeal of Application

Serial No. 75/807,556 on the issue of whether DAILY PLANNER is generic, and will do so throughout this decision.²

First, with respect to the issue of whether DAILY PLANNER is merely descriptive of applicant's services, there is no question that "daily planner" is a generic term for stationery that is an organizer. As evidence of the genericness of "daily planner" for such goods, the Examining Attorney has submitted copies of third-party registrations in which "daily planner" is listed as an item in the identifications of goods; excerpts from various websites in which "daily planners" are listed as a type of product;³ and excerpts of articles taken from the NEXIS database which refer to "daily planner" in a generic manner.⁴ In addition, the Examining Attorney has pointed to applicant's own submissions in connection with its Section 2(f) declaration, which indicate that in 1994 it produced a "Filofax Organizer Catalog." Other catalogs referenced in

² This decision issued after applicant's brief in the present appeal was filed.

³ "Plan-It Systems™-recycled, refillable line of daily planners and calendars some of which feature NatureTex™ fabric covers" (http://greenculture.com/ps/pp_planner.html); "Use an organizer or daily planner to keep track of your shopping list, receipts or special dates" (<http://shopping.altavista.com/nav.sdc?n=19200>).

⁴ "For Christmas this year, my mother received a book bag, notebooks and a full-tuition college scholarship." ("The Houston Chronicle," November 4, 2000); "Get yourself a daily planner and eliminate all those wall calendars, pocket reminders and assorted notes on the refrigerator." ("Chicago Daily Herald," January 1, 1998).

and submitted with the declaration also prominently feature organizers/desk diaries.⁵

This evidence establishes that DAILY PLANNER describes a central characteristic of applicant's services, i.e., that one of the categories of items sold through and featured in applicant's mail order catalog and on-line retail services is a "daily planner." A mark is merely descriptive if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985). Accordingly, we have no doubt that DAILY PLANNER is merely descriptive of applicant's services.

Applicant has pointed to certain third-party registrations in which the Office has registered for services, without any disclaimer, marks containing a word which is "clearly generic for a type of goods typically sold at the store." Brief, p. 12. As this Board stated in the opinion in the companion application:

⁵ Although we recognize that applicant's application is based on an intention to use the mark, rather than use, in view of applicant's reliance use of the mark THE DAILY PLANNER and its claim of acquired distinctiveness based on such use, it is appropriate for us to consider the nature of the services in terms of the way THE DAILY PLANNER and design mark is actually used.

We can give little weight to the third-party registration which applicant has submitted in which, although a certain type of product sold by the retailer is named in the mark, no disclaimer was required. It is readily apparent that items such as "lettuce,"⁶ when used in connection with restaurant services, or "buckles,"⁷ when used in connection with clothing store services, do not name a central characteristic or basic feature of the services involved.

Further, in some of the registrations the so-called generic term is not used in a generic fashion. See, for example, Registration No. 2,268,803 for LASER LOU'S, where LASER is used as a modifier of the name LOU, and Registration No. 1,453,642 for DON'T GLUE IT...SCREW IT for distributorship services in the field of metal fasteners, where SCREW is used as a verb, not a noun.

This brings us to the question of whether DAILY PLANNER has acquired distinctiveness such that it is registrable under the provisions of Section 2(f). The Examining Attorney takes the position that the term is generic for applicant's identified services, and therefore not only is applicant's evidence insufficient to prove acquired distinctiveness, but it is incapable of distinguishing applicant's services from those of others.

⁶ Registration No. 1,672,175.

⁷ Registration No. 1,733,841 for THE BUCKLE.

Before discussing the central issue in this appeal, whether DAILY PLANNER is generic for the identified services, we think it appropriate to review the evidence of acquired distinctiveness submitted by applicant. As noted, this evidence consists of a declaration that was submitted in connection with a companion application for THE DAILY PLANNER and design for the same services. Although the DP and seal effect of the companion mark create something of a different commercial impression, we have considered applicant's evidence with respect to the use of that mark. The declaration by Howard Pollack, applicant's president, states that applicant has used the term THE DAILY PLANNER as a mark or as part of a mark since 1990. Applicant has provided sales and advertising figures for only the years 1996 through 1999, to wit: sales under the mark were \$150,000 in 1996, \$275,000 in 1997, \$550,000 in 1998 and \$860,000 in 1999, and advertising costs relating to THE DAILY PLANNER mark were \$22,000 in 1996, \$27,000 in 1997, \$70,000 in 1998 and \$160,000 in 1999. The only evidence as to the nature of applicant's advertising are catalogs.

Even if we assume that DAILY PLANNER is not generic for applicant's services, it is, at the very least, highly descriptive, since it is generic for a category of goods which are offered through applicant's services. In view

thereof, the evidence of acquired distinctiveness applicant has provided regarding its use of various THE DAILY PLANNER marks is simply insufficient to demonstrate that DAILY PLANNER has acquired distinctiveness as a mark. Although applicant's sales have grown since 1996, even the \$860,000 in sales in 1999 is not particularly large when seen in the context of the highly descriptive nature of the mark. Nor are the advertising figures. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has acquired distinctiveness. See **Yamaha International Corp. v. Hoshino Gakki Co. Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

This brings us to what applicant has characterized as the principal issue on appeal, i.e., whether DAILY PLANNER is generic for mail order and online retail services featuring the sale of stationery and related gift items.

The comments of the Board in the appeal of the companion application are applicable here as well:

Applicant contends that the Examining Attorney has failed to offer any evidence that THE DAILY PLANNER is generic for applicant's services. Instead, applicant argues, all of the evidence is directed to the question of whether the term "daily planner" is generic for a type of goods, namely, organizers. Applicant insists that although a term may be generic for a type of goods sold by a retailer, it cannot simply be concluded, without further evidence, that the term is also generic for retail sale services

featuring those goods. Applicant argues, there is no showing that "daily planner" is a commonly used generic term for a store featuring the sale of organizers.

Applicant claims that [the] *Bonni Keller* case relied on by the Examining Attorney [**In re Bonni Keller Collections Ltd.**, 6 USPQ2d 1224 (TTAB 1987)] does not support the broad application of the principle that a term which is generic for a type of goods is also generic for retail store services [or mail order catalog services and computerized on-line retail services] featuring those goods. Applicant notes that in the *Bonni Keller* case the mark was LA LINGERIE and there was evidence of record that retail stores selling lingerie were called "lingerie" shops or stores. 6 USPQ2d at 1226. Here, applicant notes, there is no evidence that "daily planner" is a commonly used term for a type of store and thus the *Bonni Keller* case is not applicable.

Applicant further argues that the controlling decision in this case is *In re Seats*, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985) in which, according to applicant, the Court found a showing of genericness of the term SEATS in relation to chairs or bleachers insufficient to show that it was also generic for the service of selling seats at various events. Applicant insists that the same is true here; that whether or not DAILY PLANNER may be generic for particular goods, there is no showing or evidence that it is equally generic for the recited retail services.

As a general principle a term which is a generic name for a central characteristic of a service is incapable of distinguishing the services from like services of others. See *In re Bonni Keller Collections Ltd.*, *supra* (LA LINGERIE held incapable of distinguishing applicant's retail store services in the field of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE held incapable of functioning as a service mark to identify applicant's mail order and distributorship services in the field of

wicker furniture and accessories); In re Half Price Books, Records, Magazines, Inc., 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES held incapable of designating origin).

While applicant argues that there is no evidence that "daily planner" is a commonly used term for a store featuring the sale of organizers, we do not find specific evidence of the prior use of the term in a generic manner for stores of this type [or for catalog services and on-line retail services] necessary. It is true that in the *Bonni Keller* case, there was actual evidence on the use of the term "lingerie" in connection with the stores selling these goods, as well as the goods per se. But the same did not hold true in the *Wickerware* case. There the evidence was of use of the term "wickerware" generically with respect to products made of wicker; from this evidence the Board concluded that "the term 'wickerware' is as incapable of distinguishing the services of selling wicker as it is for the products themselves." 227 USPQ at 971. The Board went on to state:

That the evidence which the Examining Attorney introduced does not specifically demonstrate use in connection with services does not dissuade us from our conclusion as it is obvious that the only conceivable significance of the term in relation to the service of retail selling is to inform prospective customers that the services involve the sale of wickerware.

Id. At 971.

The critical issue in determining genericness of a term under any circumstances is whether members of the relevant public would primarily use or understand the designation sought to be registered to refer to the genus or category of goods or services in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ528 (Fed. Cir.

1986). In making this determination in this case, we must follow the two-step inquiry set forth in *Marvin Ginn* and reaffirmed by the Court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely:

- (1) What is the genus or category of services at issue?, and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus of category of services.

As we stated previously, and as the Board found in the companion application, the evidence demonstrates that "daily planner" is a generic name for a type of stationery item, and that this item is a feature of applicant's identified mail order and on-line retail services. Thus, we find that the term DAILY PLANNER is a generic name for a central characteristic of applicant's retail services. The category of services at issue herein is mail order or on-line retail services featuring daily planners. DAILY PLANNER, when used in connection with such services, would be understood by the relevant purchasing public as referring to retail services in which such products are featured.

Finally, applicant's reliance on ***In re Seats, Inc.***, supra, is misplaced. As the Board explained in the companion case:

[T]he Court clearly drew a distinction between the generic use of the term "seats" for chairs or

couches or bleachers and the non-generic use of the term in connection with reservation services, as opposed to the selling of seats per se, "as would for example a furniture merchant." 225 USPQ at 368. No such distinction can be made here; applicant is selling the very product that the term THE DAILY PLANNER names.

Decision: The refusals on the grounds that DAILY PLANNER is merely descriptive of applicant's services and that it has not acquired distinctiveness, and that the term is generic, are affirmed.